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Thomas Birkhoelzer

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EXAMINER

SHAN, APRIL YING

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/785,180	Applicant(s) BIRKHOELZER ET AL.	
	Examiner APRIL Y. SHAN	Art Unit 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008 and 23 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,12-14 and 22-40 is/are pending in the application.
- 4a) Of the above claim(s) 5,8-10,12,13 and 33-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-7, 14 and 22-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-2, 6-7, 14 and 22-32 have been examined.

Response to Amendment/Argument

2. The Applicant's amendment, filed 14 July 2008, has been received, entered into the record, and respectfully and carefully considered.

3. As a result of the amendment, claims 1, 5-10, 12-14, 23 and 32 have been amended. Claims 3-4, 11 and 15-21 are canceled. Claims 33-40 are newly added claims. Thus, claims 1-2, 5-10, 12-14 and 22-40 are pending.

4. Any objection/rejections not repeated below for record are withdrawn due to Applicant's amendment.

5. Applicant's amendments and argument have been fully considered, but are moot in view of new ground rejection as set forth below.

6. After previous non-final Office Action (14 April 2008) mailed out, new clarification of "Process" under 35 USC 101 in view of the Court of Appeals for the Federal Circuit in *In re Bilski*, Appeal No. 2007-1130 was provided to the examiner and the public in May, 2008. After careful review of method claims 1-2, 6-7, 14, 22, 30 and 32 of the instant application in view of *In re Bilski*, the examiner believes claims 1-2, 6-7, 14, 22, 30 and 32 are not statutory. Since claims 1-2, 6-7, 14, 22, 30 and 32 were not rejected under 35 USC 101 in view of *In re Bilski* in the previous Office Action, the examiner rejects claims 1-2, 6-7, 14, 22, 30 and 32 under 35 USC 101 in the current Office Action and the current Office Action is Non-final.

Election/Restrictions

7. Applicant's election **without traverse** of electing Group I (claims 1-2, 6-7, 14 and 22-32), in the reply filed on 23 December 2008 is acknowledged.

Since the Applicant did not state no-elected Group II (claims 5, 8-10, 12-13 and 33-40) is withdrawn or canceled, Group II (claims 5, 8-10, 12-13 and 33-40) is hereby withdrawn from consideration and claims 1-2, 6-7, 14 and 22-32 have been examined.

Information Disclosure Statement

8. The information disclosure statement filed 9 April 2007 fails to comply with 37 CFR 1.98(a)(3) because German Office action does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "computer-readable storage medium" in claims 14 and 23, lacks antecedent basis in the specification.

Claim Objections

10. Claims 1-2, 6-7, 14 and 32 are objected to because of the following informalities:

As per **claim 1**, “an electronic data processing method method” is being recited in the preamble. Please remove one “method” from the preamble.

Further, “selecting a user group identifier and acquiring at least one data key associated therewith from a centralized data store including all available keys, at least one user group identifier and at least one data key being associated with one another” is being recited. However, this newly added claim limitation is grammatically incomprehensible. Please clarify. In order to further exam on the merits of this claim, the examiner assumes “at least one user group identifier” refers to “selecting a user group identifier” and “at lest one data key” refers to “acquiring at least one data key”.

Any claim not specifically addressed, above, is being objected as incorporating the deficiencies of a claim upon which it depends.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1-2, 6-7, 14, 22-30 and 32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-2, 6-7, 14, 22-30 and 32 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claim is neither positively tied to a particular machine that accomplishes the claimed method steps nor transforms underlying subject matter, and therefore do not qualify as a statutory process. The method recited in claims 1-2, 6-7, 14, 22-30 and 32, such steps of performing a security check, associating the user identity, selecting a user group identifier and performing encrypting and decrypting data are broad enough that the claim could be completely performed manually, mentally, verbally or without a machine. Further, although a centralized data store is being recited, it can be reasonably interpreted as database, which is software per se and selecting a user group identifier from a centralized data store can be completely performed manually by a human user. Furthermore, a centralized data store is not required in the performing of the step and therefore is neither an explicitly recited structural tie or inherently involved in the step. Therefore, claims 1-2, 6-7, 14, 22-30 and 32 do not define a statutory process.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 1, 2, 6, 7, 14 and 22-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deindl et al. (U.S. Patent No. 6,031,910) in view of Sasaki (U.S. Patent No. 7,272,230).

As per **claim 1**, Deindl et al. discloses an electronic data processing method, comprising:

performing a security check to ascertain a user identity by comparing entered identity information with stored user identity data (e.g. col. 6, lines 33-43);

associating the user identity with a user identifier (personal identification number, a password and/or biometric identification – e.g. col. 6, lines 37-39. Please note personal identification number, a password and/or biometric identification corresponds to Applicant's user identifier);

associating the user identifier with at least one user group identifier (e.g. col. 6, lines 22-23 and 44-56);

selecting a user group identifier and at least one user group identifier and at least one data key being associated with one another (e.g. col. 6, lines 20-32);

performing at least one of encrypting and decrypting data using the acquired at least one data key and inhibiting user recognition of the acquired at least one data key (generating one or more cryptographic keys in the chip card for use by a computer...encrypting at least one of cryptographic keys in the chip card with a second cryptographic key" – e.g. col. 6, lines 23-32 and "encrypting at least one set of data by means of the cryptographic keys in the computer" - e.g. col. 6, lines 26-28. Please note the one or more cryptographic keys reside on the chip card and they are encrypted. Therefore, the keys are unviewable by the user).

Although Deindl et al. further discloses the encrypted data and the associated key are stored together in one file, e.g. in a computer, in a database, or is distributed over a network, Deindl et al. does not explicitly disclose selecting a user group identifier and at least one user group identifier and acquiring the data key from a centralized data

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store including all available keys, at least one data key being associated with one another. However, Sasaki met the claimed limitation by disclosing a second management database 16 includes a "group ID" and a corresponding "group key" in fig. 31 and when the obtained group ID is registered, so that a group key corresponding to the group ID is read out (e.g. second management database 16 in fig. 31, col. 29, lines 5-11, col. 7, line 53 – col. 8, line 9 and col. 32, lines 3-10).

Deindl et al. - Sasaki are analogous art because they are from a similar field of endeavor in data protection through encryption/decryption. Thus, it would have been obvious to a person with ordinary skill in the art, at the time of invention, to modify the teachings of Deindl et al. with selecting a user group identifier and at least one user group identifier and acquiring the data key from a centralized data store including all available keys, at least one data key being associated with one another taught by Sasaki in order to provide centralized key management in a cryptographic system.

This combination would predictably result a well known centralized database to retrieve group keys corresponding to group identifiers. It has been held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does not more than yield predictable results." *KSR.*, 127 S. Ct. at 1739, 82USPQ2d at 1395 (2007) (citing *Graham*, 383 U.S. at 12).

As per **claim 2**, Deindl et al. further discloses wherein the security check involves at least one of checking a user-specific biometric data, an electronic key and a mechanical key (e.g. col. 6, lines 33-43).

As per **claim 6**, Deindl et al. further discloses wherein a plurality of data keys are simultaneously assignable to one user identifier (e.g. col. 6, lines 23-25).

As per **claim 7**, Deindl et al. – Sasaki further discloses wherein the data are medically relevant, wherein the users include personnel within a medical facility, and wherein common user group identifiers are assigned the same data key (e.g. col. 7, lines 57-63 of Deindl et al. and col. 7, lines 59 -62 of Sasaki).

As per **claim 14**, Deindl et al. - Sasaki discloses the claimed method of steps as applied above in claim 1. Therefore, Deindl et al. - Sasaki discloses the claimed information stored on a storage medium for carrying out the method of steps.

As per **claim 32**, Deindl et al. - Sasaki further discloses wherein users associated with a common user group are assigned the same data key (e.g. col. 7, lines 57-63 of Deindl et al. and col. 7, lines 59 -62 of Sasaki).

As per **claims 22 and 31**, they are rejected using the similar rationale as rejecting claim 1 above. Please note Deindl et al. - Sasaki discloses the same data key being assignable to the plurality of users (e.g. col. 7, lines 57-63 of Deindl et al. and col. 7, lines 59 -62 of Sasaki)

As per **claim 23**, Deindl et al. - Sasaki discloses the claimed method of steps as applied above in claim 22. Therefore, Deindl et al. - Sasaki discloses the claimed information stored on a storage medium for carrying out the method of steps.

As per **claim 24**, Deindl et al. further discloses wherein the security check involves checking biometric data of the user (e.g. col. 6, lines 33-43).

As per **claim 25**, Deindl et al. further discloses wherein the security check involves checking a user-specific at least one of electronic and mechanical key ("In reading a file the doctor must be in possession of a user card 310. The user card 310 legitimizes the doctor as an authorized doctor in a particular specialty – e.g. col. 4, lines 53 –55 and col. 7, lines 57-63. Please note a doctor's user card corresponds to Applicant's a user-specific at least one of electronic and mechanical key).

As per **claims 26-27**, Deindl et al. further discloses wherein the data key is ascertained by comparing the data obtained in the security check with content of a data key memory and wherein the data obtained in the security check are compared with the content of the data key memory using a data telecommunication device (e.g. col. 4, lines 26-36 and col. 4, lines 53-67).

As per **claim 28**, Deindl et al. further discloses wherein a plurality of data keys are simultaneously assignable to one user (e.g. col. 6, lines 23-25).

As per **claims 29 and 30**, Deindl et al. further discloses wherein the data are medically relevant, wherein the users include personnel at a medical facility, and wherein common user groups are assigned the same data key (e.g. col. 7, lines 57-63).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. However, applicants are **strongly urged** to consider the cited references carefully and distinguish them from the instant claims in accordance with 37CFR 1.111c when presenting an amendment in response to the current Office Action.

- Swanke et al. (U.S. Patent No. 7,212,987) discloses acquiring a key from a central database
- Persson et al. (U.S. Pub. No. 2007/0055877) teaches using a group key as an index to retrieve a trusted group key

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/
Examiner, Art Unit 2435

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